

REMARKS

In the Office Action,¹ the Examiner objected to the title of the invention; rejected claims 1, 3, and 31 under 35 U.S.C. § 102(e) as being anticipated by US Patent Application Publication No. 2003/0185136 to *Kaiho*; rejected claims 2 and 4 under 35 U.S.C. § 103 as unpatentable over *Kaiho* in view of US Patent No 6,747,938 to *Kim*; rejected claims 5, 8, 10, 19, 20, 22, 24, and 25 under 35 U.S.C. § 103 as unpatentable over *Kaiho* in view of US Patent Application Publication No. 2002/0012313 to *Kimura*; rejected claims 6, 13, and 14 under 35 U.S.C. § 103 as unpatentable over *Kaiho* in view of US Patent No. 6,819,646 to *Kitaoka*; rejected claim 7 under 35 U.S.C. § 103 as unpatentable over *Kaiho* and *Kim* and further in view of *Kitaoka*; rejected claims 9, 11, 12, 17, 18, 21, and 23 under 35 U.S.C. § 103 as unpatentable over *Kaiho*, *Kim*, and *Kitaoka* and further in view of *Kimura*; rejected claims 15, 16, and 28 under 35 U.S.C. § 103 as unpatentable over *Kaiho* and US Patent No. 5,048,000 to *Tsuji* and further in view of *Kimura*; rejected claims 26 and 30 under 35 U.S.C. § 103 as unpatentable over *Kaiho* in view *Tsuji*; and rejected claims 27 and 29 under 35 U.S.C. § 103 as unpatentable over *Kaiho*, *Kim*, *Kitaoka*, and *Kimura* and further in view of *Tsuji*.

By this response, the title has been amended. Claims 1, 4, 12, 15, 17, 20 and 21 have been amended as to matters of form only; and claims 1-31 remain pending and under consideration.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Specification Objections

The Examiner objected to the title as not descriptive. Office action, page 2. Applicants have amended the title to read "Optical Pickup Apparatus for Recording or Reproducing Information for an Optical Information Recording Medium." Therefore, Applicants respectfully request that the objection be withdrawn.

35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1, 3, and 31 under 35 U.S.C. § 102(e) as being anticipated by *Kaiho*. In order to properly establish that *Kaiho* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Kaiho does not disclose each and every element of Applicants' claimed invention. Amended claim 1 recites a combination of features including, for example, "a chromatic aberration correcting element." The Examiner alleges that *Kaiho* teaches a chromatic aberration correcting element via the "concave lens of Figure 4 element 41 and paragraph [0071]." Office Action, page 4. This is not correct.

Kaiho does not include any "chromatic aberration correcting element," as recited in claim 1. *Kaiho* instead teaches a concave lens 41 facing two different, longer wavelength, laser diodes. Paragraph 0070; Figure 4, items 1 and 5. The concave lens

41 does not face a third, shorter wavelength, laser diode. Figure 4, item 31. Neither the concave lens 41, nor any other element of *Kaiho*, constitutes “a chromatic aberration correcting element,” as recited in claim 1. Instead, the concave lens 41 is for maintaining a relatively small finite optical ratio while disposing laser diodes 1 and 5 at a predetermined distance from an objective lens (Paragraph 0080). The finite optical ratio is important for spherical aberration considerations (Paragraph 0009), and the concave lens 41 is used for combining features of infinite and finite optical systems (Paragraph 0015), not for chromatic aberration considerations. Therefore, *Kaiho* does not teach “a chromatic aberration correcting element,” as recited in claim 1.

Because *Kaiho* does not teach or suggest each and every element recited by amended claim 1, *Kaiho* cannot anticipate this claim. Claim 1 is allowable over the art of record. Claims 2-31 are also allowable at least due to their dependence from claim 1. Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 3, and 31 under 35 U.S.C. § 102(e).

35 U.S.C. § 103

Applicants respectfully traverse the rejections of claims 2-31 under 35 U.S.C. § 103. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the prior art references, when combined, must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the

prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

Regarding Claims 2 and 4

Applicants respectfully traverse the rejections of claims 2 and 4 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, neither *Kaiho* nor *Kim*, taken alone or in combination, teaches or suggests each and every element of Applicants’ claims.

Dependent claims 2 and 4 include all of the elements of independent claim 1, including, for example “a chromatic aberration correcting element.” As set forth above, *Kaiho* fails to teach or suggest “a chromatic aberration correcting element,” as required by claim 1.

The Examiner alleges that *Kim* teaches thicknesses and a spherical aberration correcting structure. Office action, page 5. Even assuming these allegations are true, which Applicants do not concede, *Kim* fails to cure the deficiencies of *Kaiho* discussed above. That is, *Kim* does not teach or suggest “a chromatic aberration correcting element,” as recited in claim 1, and required by claims 2 and 4.

Accordingly, *Kaiho* and *Kim* fail to establish a prima facie case of obviousness with respect to claims 2 and 4, at least because the references fail to teach each and every element required by the claims.

Regarding Claims 5, 8, 10, 19, 20, 22, 24 and 25

Applicants respectfully traverse the rejection of claims 5, 8, 10, 19, 20, 22, 24 and 25 under 35 U.S.C. § 103. A prima facie case of obviousness has not been

established because, among other things, neither *Kaiho* nor *Kimura*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Dependent claims 5, 8, 10, 19, 20, 22, 24 and 25 include all of the elements of independent claim 1, including, for example "a chromatic aberration correcting element." As set forth above, *Kaiho* fails to teach or suggest "a chromatic aberration correcting element," as required by claim 1.

The Examiner alleges that *Kimura* teaches objective lens features, light flux features, and spherical aberration correcting element features. Office action, pages 6-9. Even assuming these allegations are true, which Applicants do not concede, *Kimura* fails to cure the deficiencies of *Kaiho* discussed above. That is, *Kimura* does not teach or suggest, along with the other elements, "a chromatic aberration correcting element," as recited in claim 1, and required by claims 5, 8, 10, 19, 20, 22, 24 and 25.

Kimura cannot cure the deficiency of *Kaiho* since *Kimura* does not teach or suggest how to include chromatic aberration correction techniques in the system of *Kaiho*. For instance, *Kimura* teaches chromatic aberration correction techniques at paragraphs 470 and 473 for a system having two light sources (Figure 1, items 11 and 12). However, using a different configuration, *Kaiho*'s system has three light sources (Figure 4, items 1, 5, and 31). Neither *Kaiho* nor *Kimura*, alone or in combination, teach or suggest how to modify the system of *Kaiho* to include the chromatic aberration correction techniques of *Kimura*. Therefore, *Kimura* does not teach "a chromatic aberration correcting element," as recited in claim 1, and required by claims 5, 8, 10, 19, 20, 22, 24 and 25.

Accordingly, *Kaiho* and *Kimura* fail to establish a prima facie case of obviousness with respect to claims 5, 8, 10, 19, 20, 22, 24 and 25, at least because the references fail to teach each and every element required by the claims.

Regarding Claims 6, 13, and 14

Applicants respectfully traverse the rejection of claims 6, 13, and 14 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, neither *Kaiho* nor *Kitoaka*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Dependent claims 6, 13, and 14 include all of the elements of independent claim 1, including, for example "a chromatic aberration correcting element." As set forth above, *Kaiho* fails to teach or suggest "a chromatic aberration correcting element," as required by claim 1.

The Examiner alleges that *Kitoaka* teaches base board attachment features, collimator features and distance features. Office action, pages 10-11. Even assuming these allegations are true, which Applicants do not concede, *Kitoaka* fails to cure the deficiencies of *Kaiho* discussed above. That is, *Kitoaka* does not teach or suggest "a chromatic aberration correcting element," as recited in claim 1, and required by claims 6, 13, and 14.

Accordingly, *Kaiho* and *Kitoaka* fail to establish a prima facie case of obviousness with respect to claims 6, 13 and 14, at least because the references fail to teach each and every element required by the claims.

Regarding Claim 7

Applicants respectfully traverse the rejection of claim 7 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, none of the references to *Kaiho*, *Kim*, or *Kitoaka*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Dependent claim 7 includes all of the elements of independent claim 1, including, for example "a chromatic aberration correcting element." As set forth above for claim 4, the combination of *Kaiho* and *Kim* fails to teach or suggest "a chromatic aberration correcting element," as required by claim 1.

The Examiner alleges that *Kitoaka* teaches base board attachment features. Office action, page 11. Even assuming these allegations are true, which Applicants do not concede, *Kitoaka* fails to cure the deficiencies of *Kaiho* and *Kim* discussed above. That is, *Kitoaka* does not teach or suggest "a chromatic aberration correcting element," as recited in claim 1, and required by claim 7.

Accordingly, *Kaiho*, *Kim*, and *Kitoaka* fail to establish a prima facie case of obviousness with respect to claim 7, at least because the references fail to teach each and every element required by the claim.

Regarding Claims 9, 11, 12, 17, 18, 21 and 23

Applicants respectfully traverse the rejection of claims 9, 11, 12, 17, 18, 21 and 23 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, none of the references to *Kaiho*, *Kim*, *Kitoaka*, or *Kimura*

taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Dependent claims 9, 11, 12, 17, 18, 21 and 23 include all of the elements of independent claim 1, including, for example "a chromatic aberration correcting element." As set forth above for claim 7, the combination of *Kaiho*, *Kim*, and *Kitoaka* fails to teach or suggest "a chromatic aberration correcting element," as required by claim 1.

The Examiner alleges that *Kimura* teaches divergent flux features, chromatic aberration correcting element features, and spherical aberration correcting element features. Office action, pages 12-15. Even assuming these allegations are true, which Applicants do not concede, *Kimura* fails to cure the deficiencies of *Kaiho*, *Kim*, and *Kitoaka* discussed above. That is, *Kimura* does not teach or suggest, along with the other claim elements, "a chromatic aberration correcting element," as recited in claim 1, and required by claims 9, 11, 12, 17, 18, 21 and 23.

Kimura cannot cure the deficiencies of *Kaiho*, *Kim*, and *Kitoaka*, discussed above, since *Kimura* does not teach or suggest how to include chromatic aberration correction techniques in the system of *Kaiho*. For instance, *Kimura* teaches chromatic aberration correction techniques at paragraphs 470 and 473 for a system having two light sources (Figure 1, items 11 and 12). However, using a different configuration, *Kaiho*'s system has three light sources (Figure 4, items 1, 5, and 31). Neither *Kaiho* nor *Kimura*, alone or in combination, teach or suggest how to modify the system of *Kaiho* to include the chromatic aberration correction techniques of *Kimura*. Therefore, *Kimura*

does not teach “a chromatic aberration correcting element,” as recited in claim 1, and required by claims 9, 11, 12, 17, 18, 21 and 23.

Accordingly, *Kaiho*, *Kim*, *Kitoaka*, and *Kimura* fail to establish a prima facie case of obviousness with respect to claims 9, 11, 12, 17, 18, 21 and 23, at least because the references fail to teach each and every element required by the claims.

Regarding Claims 15, 16 and 28

Applicants respectfully traverse the rejection of claims 15, 16 and 28 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, none of the references to *Kaiho*, *Tsuji*, or *Kimura* taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Dependent claims 15, 16 and 28 include all of the elements of independent claim 1, including, for example “a chromatic aberration correcting element.” As set forth above, *Kaiho* fails to teach or suggest “a chromatic aberration correcting element,” as required by independent claim 1.

It is not clearly established on the record why the Examiner relies on *Tsuji* for the rejection of claims 15 and 16. Nevertheless, *Kimura* fails to cure the deficiencies of *Kaiho*, discussed above, and *Tsuji*, discussed below. That is, *Kimura* does not teach or suggest, along with the other elements, “a chromatic aberration correcting element,” as recited in claim 1, and required by claims 15, 16 and 28.

The Examiner alleges that *Kimura* teaches chromatic aberration correcting element features and spherical aberration correcting element features. Office Action,

pages 15-16. Even assuming these allegations are true, which Applicants do not conceded, *Kimura* cannot cure the deficiencies of *Kaiho* and *Tsuji*.

Kimura does not teach or suggest how to include chromatic aberration correction techniques in the system of *Kaiho*. For instance, *Kimura* teaches chromatic aberration correction techniques at paragraphs 470 and 473 for a system having two light sources (Figure 1, items 11 and 12). However, using a different configuration, *Kaiho*'s system has three light sources (Figure 4, items 1, 5, and 31). Neither *Kaiho* nor *Kimura*, alone or in combination, teach or suggest how to modify the system of *Kaiho* to include the chromatic aberration correction techniques of *Kimura*. Therefore, *Kimura* does not teach "a chromatic aberration correcting element," as recited in claim 1, and required by claims 15, 16 and 28.

Accordingly, *Kaiho*, *Tsuji*, and *Kimura* fail to establish a prima facie case of obviousness with respect to claims 15, 16 and 28, at least because the references fail to teach each and every element required by the claims.

Regarding Claims 26 and 30

Applicants respectfully traverse the rejection of claims 26 and 30 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, none of the references to *Kaiho* or *Tsuji* taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Dependent claims 26 and 30 include all of the elements of independent claim 1, including, for example "a chromatic aberration correcting element." As set forth above,

Kaiho fails to teach or suggest “a chromatic aberration correcting element,” as required by claim 1.

The Examiner alleges that *Tsuji* teaches objective optical element features. Office action, pages 17-18. Even assuming these allegations are true, which Applicants do not concede, *Tsuji* fails to cure the deficiencies of *Kaiho* discussed above. That is, *Tsuji* does not teach or suggest “a chromatic aberration correcting element,” as recited in claim 1, and required by claims 26 and 30.

Accordingly, *Kaiho* and *Tsuji* fail to establish a prima facie case of obviousness with respect to claims 26 and 30, at least because the references fail to teach each and every element required by the claims.

Regarding Claims 27 and 29

Applicants respectfully traverse the rejection of claims 27 and 29 under 35 U.S.C. § 103. A prima facie case of obviousness has not been established because, among other things, none of the references to *Kaiho*, *Kim*, *Kitoaka*, *Kimura*, or *Tsuji* taken alone or in combination, teaches or suggests each and every element of Applicants’ claims.

Dependent claims 27 and 29 include all of the elements of independent claim 1, including, for example “a chromatic aberration correcting element.” As set forth above for claim 23, the combination of *Kaiho*, *Kim*, *Kitoaka*, and *Kimura* fails to teach or suggest “a chromatic aberration correcting element,” as required by claim 1.

The Examiner alleges that *Tsuji* teaches objective optical element features. Office action, page 18. Even assuming these allegations are true, which Applicants do

not concede, *Tsuji* fails to cure the deficiencies of *Kaiho*, *Kim*, *Kitoaka*, and *Kimura* discussed above. That is, *Tsuji* does not teach or suggest "a chromatic aberration correcting element," as recited in claim 1, and required by claims 27 and 29.

Accordingly, *Kaiho*, *Kim*, *Kitoaka*, *Kimura*, and *Tsuji* fail to establish a prima facie case of obviousness with respect to claims 27 and 29, at least because the references fail to teach each and every element required by the claims.

In view of the above remarks, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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